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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,215	11/29/2000	Kazuo Sasaki	1405.1028/JDH	6349

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EXAMINER

VU, THONG H

ART UNIT PAPER NUMBER

2142

DATE MAILED: 03/02/2004

4

Please find below and/or attached an Office communication concerning this application or proceeding.

John

Office Action Summary

Application No.

09/725,215

Applicant(s)

SASAKI ET AL.

Examiner

Thong H Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2000.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-9 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 29 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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1. Claims 1-9 are pending.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 are rejected under the judicially created doctrine of double patenting over claims 1-19 of U. S. Patent No. 6,564,244 B1 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Application:

(Claim 1) A status setting method in which a user terminal can send, receive, and display a user status and a character message by sharing one or more virtual spaces set up on a network comprising:

preparing a status table in which configurable user statuses are registered for each virtual space (i.e.: storing the status table);

obtaining the status table of a virtual space in which a user terminal participates every time the user terminal participates in the virtual space (i.e.: monitoring the status);

setting a user status on each virtual space for the virtual space based on an obtained status table (i.e.: change the status based on a preference); and

sending to, receiving from, and displaying for each virtual space the user status set for each virtual space (i.e.: notify to user).

Patent '244:

(Claim 1) For utilization by a communication system comprising user terminals connected to a network, wherein a plurality of the user terminals share at least one of a plurality of virtual spaces, establishing at least one chat network active for simultaneous bi-directional communication, a chat network search method comprising steps of:

storing at least one chat network search preference linked to at least one user terminal;

monitoring a status of the at least one chat network for changes according to predetermined parameters related to the at least one chat network search preference and, in response to every occurring status change,

storing chat network status information signaling a changed-status chat network; determining, based upon the stored chat network status information, whether a changed-status chat network meets the at least one chat network search preference linked to the at least one user terminal; and

notifying the at least one user of any changed status chat network meeting the chat network search preference linked to the at least one user terminal.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. § 103 as being unpatentable over Kitahara et al [Kitahara 5,995,096] in view of Matsuda et al [Matsuda 6,577,328 B2]

3. As per claim 1, Kitahara discloses a status setting method in which a user terminal can send, receive, and display a user status and a character message by sharing one or more virtual spaces set up on a network (i.e.: conference window) comprising:

preparing a status table [Kitahara, tables 400, 410 Fig 3, col 6 lines 24-30];

obtaining the status table of a virtual space in which a user terminal participates every time the user terminal participates in the virtual space [Kitahara, a setting of the participant information table, col 6 line 61-col 7 line 8];

setting a user status on each virtual space for the virtual space based on an obtained status table [Kitahara, a setting is made to the conference information table, a setting of the participant information table, col 6 line 61-col 7 line 8]; and

sending to, receiving from, and displaying for each virtual space the user status set for each virtual space [Kitahara, preparing for the transmission and reception data, col 8 lines 53-58; col 11 lines 14-25]

However Kitahara does not detail the status table in which configurable user statuses are registered for each virtual space. A skilled artisan would motivation to improve the method for registering the status information to help user in configuration setup and found Matsuda teaching. Matsuda taught a program for controlling a shared virtual space providing a communication control table is registered including a status transition of the virtual life object for configuration [Matsuda col 18 lines 28-54]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the status table in which configurable user statuses are registered as taught by Matsuda into the Kitahara's apparatus in order to utilize the status table. Doing so would provide a quick and simple process to implement the information associated with the growth process of virtual object on the sharing virtual space environment.

4. Claim 9 contains the similar limitations set forth of apparatus claim 1. Therefore, claim 9 is rejected for the similar rationale set forth in claim 1.

5. As per claim 2, Kitahara-Matsuda disclose the user status and a user attribute defining a configurable user statuses are correlatively registered in the status table [Matsuda col 18 lines 28-54].

6. As per claim 3, Kitahara-Matsuda disclose a common table in which prescribed user statuses are registered is previously prepared, and said common table is obtained

if no status table is prepared for a virtual space in which user terminals participate, and a user status on said virtual space is set for the virtual space based on an obtained common table [Matsuda col 18 lines 28-54].

7. As per claim 4, Kitahara-Matsuda disclose the setting of a user status by a user is accepted (i.e.: registered) [Matsuda col 18 lines 28-54].

8. As per claim 5, Kitahara-Matsuda disclose said user terminal can display a user status with a symbol (i.e.: a virtual object) , the user status and the symbol are correlatively registered in a status table, and a status of another user sharing a virtual space is displayed with a symbol relating to the user status [Matsuda, col 17 lines 35-47].

9. As per claim 6, Kitahara-Matsuda disclose a list of user statuses registered in an obtained status table is displayed independently for each virtual space in which user terminals participate, selection of any user statuses on the list is accepted for each virtual space, and a user status is set for each virtual space [Matsuda col 13 line 65-col 14 line 7].

10. As per claim 7, Kitahara-Matsuda disclose a computer-readable recording medium having a status setting module [Kitahara, col 6 line 61-col 7 line 8]

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11. As per claim 8, Kitahara-Matsuda disclose a transmission medium transmitting a status setting module [Kitahara, FTP module, col 11 line 50-col 12 line 5].

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (703)-305-4643.

The examiner can normally be reached on Monday-Thursday from 8:00AM- 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Jack Harvey*, can be reached at (703) 305-9705.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9700.

Any response to this action should be mailed to: Commissioner of Patent and Trademarks, Washington, D.C. 20231 or faxed to :

After Final (703) 746-7238

Official: (703) 746-7239

Non-Official (703) 746-7240

Hand-delivered responses should be brought to Crystal Park 11,2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Thong Vu
Patent Examiner
Art Unit 2142

